IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Tadayuki KAMEYAMA et al.** Art Unit: **2871**

Application Number: **10/522,187** Examiner: **Jessica M. Merlin**

Filed: **September 21, 2005** Confirmation Number: **1489**

For: **POLARIZER, OPTICAL FILM USING IT, IMAGE DISPLAY UNIT USING THEM**

Attorney Docket Number: **043168**
Customer Number: **38834**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 3, 2010

Sir:

This Request is filed concurrent with a Notice of Appeal in compliance with 37 C.F.R. §41.31. Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

REMARKS

Claims 1-3 and 5-26 are currently pending.

Claims 1, 4-7, 9, 10 and 26 under 35 U.S.C. §103(a) as being unpatentable over Otsuka (JP 06-347641). All additional rejections of claims 2, 3, 8, 11-15, 17, 20, 21 and 23 depend upon the primary rejection of claim 1 based on Otsuka.

Applicants respectfully submit that it is clear error to maintain that Otsuka provides for all the features of the present invention and thereby renders the present invention obvious under 35 U.S.C. §103. Specifically, Otsuka does not provide for a polarizer containing a dichroic

material in a matrix wherein an in-plane retardation at a measurement wavelength providing no absorption is in a range of 950 to 1350nm, nor is there any manner whereby a skilled artisan could derive this feature of the claims from Otsuka.

The current rejection of claim 1 is first set forth on page 3 of the March 25, 2009 Office Action which cites to the English Abstract of Otsuka as disclosing a polarizer containing a dichroic material in a matrix. Further, the rejection points to the preferred double refractive index of the base material as a $\Delta n \geq 0.025$ which gives an in-plane retardation of $\geq 13*0.025 \geq$ 325nm, and declares that this disclosure overlaps the claimed range. Thereafter, the rejection asserts that the skilled artisan would have found it obvious to modify the display device of Otsuka with an in-plane retardation at a measurement wavelength providing no absorption is in a range of 950 to 1350 nm on the basis that doing so would provide a polarizing film which decreases leaking light in a diagonal direction as set forth in the abstract of Otsuka.

In the response of August 25, 2009, applicants respectfully noted that the double refractive index described in Otsuka is that of a base prior to dyeing with dichroism pigment and does not coincide to the feature of applicants' claim 1 that the range is that of a polarizer. Specifically, as set forth in paragraph [0022] of Otsuka, the invention thereof is focused on the base material having a proper double refractive index prior to dyeing. As such, Otsuka's teaching that the double refractive index of the base material prior to dyeing is distinct from the claimed in-plane retardation of the polarizer after the dichoric material is added. Hence, Otsuka does not disclose an in-plane retardation of a polarizer as the rejection asserts.

In the "Response to Arguments" section at page 16 of the following February 4, 2010 Office Action the Examiner states that the pigment of Otsuka is irrelevant to the double refractive index because it is added in small concentration, and that the limitations of claim 1 do not require the measurement of the double refractive index of the polarizer is measured after the addition of the dichroic material. Specifically, the Response states:

> "...applicant argues that the double refractive index of Otsuka is measured prior to dyeing and therefore does not meet the limitations of claim 1. However, as noted in paragraph [0014] of Otsuka, the weight concentration of the pigment is as low as 0.05%. Because the film is largely composed of the polymer matrix, the double refractive index will be largely due to the uniaxial stretching of the polymer matrix rather than addition of the pigment material. Further, the limitations of claim 1 do not require the measurement of the double refractive index of the polarizer is measured after the addition of the dichroic material."

Applicants' respectfully submit that this is clear error. First, Claim 1 clearly states that the measurement is of a polarizer containing a dichroic material. Further, the Examiner has relied on Otsuka because of its apparent disclosure of a dichroic pigment added to a PVA. Hence, the resulting characteristics must be those of the completed device. Rather, as noted above, the measurement which the Examiner relies upon for the in-plane retardation characteristic is referring to the base material prior to dyeing and any further processing which results in the device of Otsuka. The fact that the weight concentration of the pigment maybe low

in Otsuka is also inappropriate since the clear purpose of a dyeing pigment and other processing of the base material is to affect the characteristics of the resulting film.

Moreover, under U.S. patent law, as set forth in *Takeda v. Alphapharm* 492 F.3d 1350, 1356-1357; 83 USPQ2d 1169 (Fed. Cir. 2007):

> While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *KSR*, 127 S. Ct. at 1731.

In the current instance, Otsuka at least does not provide any reason for a skilled artisan to ascertain the formation of a polarizer wherein the in-plane retardation at a measurement wavelength providing no absorption at 950 to 1350nm for a polarizer containing a dichloric material in a matrix. Rather, as noted above Otsuka is at most disclosing a preferred double refractive index of the base material prior to adding a dyeing pigment and forming the resultant film. Wherefore, applicants respectfully submit that it is clear error to assert that Otsuka provides for the polarizer as claimed.

In view of the above remarks, Applicants submit that the rejection of parent claim 1, and by reliance all pending dependent claims, is improperly the result of clear error. Accordingly, it is respectfully requested that the rejection of the claims be withdrawn and the application be passed on to allowance.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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